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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

059864.01572

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Typed or printed

Name _____

Application Number:

10/517,533

Filed:

January 4, 2005

First Named Inventor:

Aki Niemi, et al.

Art Unit: 2618

Examiner: Fayyaz ALAM

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

Applicant/Inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed (Form PTO/SB/96)

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August 6, 2009

Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Aki NIEMI et al.

Application No.: 10/517,533

Filed: January 4, 2005

For: METHOD AND SYSTEM TO SUBSCRIPTION OF EVENTS USING SIP PROTOCOL

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Confirmation No.: 8981

Art Unit: 2618

Examiner: Fayyaz Alam

Attorney Dkt. No.: 059864.01572

August 6, 2009

Sir:

Applicants hereby submit this Pre-Appeal Brief Request for Review (“PABRR”) of the final rejections of claims 1-41 in the above identified application. Claims 1-41 were finally rejected in the Final Office Action dated March 17, 2009 (“Office Action”). Applicants filed a Response to the Office Action on June 9, 2009, and the Office issued an Advisory Action dated June 23, 2009 maintaining the final rejections of claims 1-41. Applicants hereby appeal these rejections and submit this Pre-Appeal Brief Request for Review.

Clear Error 1: Rendering arguments supporting the patentability of claims 38 and 39 moot in view of claim amendments is clearly erroneous.

In view of the incomplete remarks presented in the Office Action, Applicants submitted in the Response that all of the Applicants arguments were not addressed and the Office Action was incomplete. In the Office Action dated March 17, 2009, there was no indication that the rejection of claims 38 and 39 under 35 U.S.C. §101, or, under 35 U.S.C. §112, first paragraph, was considered. Applicants provided detailed reasons why both rejections should have been withdrawn. However, the substance of such arguments were not addressed.

In response, the Advisory Action alleged that “Applicant presented newly amended claims that included the amendment of claim 38 and 39. Therefore, arguments with respect to such newly amended claims are moot and the finality of the action was proper.” Applicants respectfully submit that the Advisory Action seems to confuse the criteria set forth by the MPEP requiring a complete and clear examiner’s action (See MPEP 707.07 and MPEP 707.07(f)). Chapter 7, §707.07(f) of the MPEP, for instance, clearly enunciates the examiner’s burden of providing clear explanations and providing answer the substance of the applicant’s arguments. Neither the MPEP, case law, or patent law, provide a waiver of the requirement of an examiner to answer all material traversed by an Applicant when the claims are amended. All material traversed by an applicant should be addressed by the examiner. Otherwise, it will render the Office Action incomplete and nonresponsive. Therefore, because the Office Action failed to comply with the criteria set forth in the MPEP, Applicants respectfully submit that the Office Action rendering the arguments presented in the Office Action moot was clear error.

Clear Error 2: Rendering the subject matter recited in claims 38 and 39 non-statutory subject matter is clearly erroneous.

The Office Action rejected claims 38 and 39 under §101 for allegedly being directed to non-statutory subject matter. The rejection alleged that the computer readable medium is not defined in the specification and that claims 38 and 39 will be considered non-statutory subject matter absent support in the specification. It is respectfully submitted that this rejection contains clear errors.

What is disclosed in the specification has no bearing on patentability under the statutory classes of invention governed by 35 U.S.C. §101. Furthermore, “A computer readable medium” is statutory subject matter under U.S. patent laws. Support for the definition of a computer readable medium is provided by *In re Lowry*, 32 F.3d 1579, 1583-1854, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994), which states: “When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” (see §2106.01 of the MPEP). As can be clearly observed from the court’s decision in *Lowry* a computer readable medium is statutory subject matter under §101. By having software recorded on a computer readable medium, it becomes structural and functional with respect to that medium, and, thus, statutory subject matter. Applicants respectfully submit that the rendering of the subject matter recited in claims 38 and 39 non-statutory subject matter is clearly erroneous.

Clear Error 3: Rendering the subject matter recited in claims 38 and 39 as failing to comply with 35 USC §112, first paragraph, is clearly erroneous.

In the Office Action, claims 38 and 39 were rejected under §112, first paragraph, because the computer readable medium is not defined in the specification and is, thus, non-statutory subject matter absent support in the specification. This rejection is respectfully traversed. FIG. 4 of the present application illustrates a process which defines a new event package for event registrations of a user to be implemented by a registrar and used by a presence server 303. The user may be a computer terminal 123 or laptop 112 which may include a computer readable medium (see lines 23-33 of page 7 of the specification). A computer readable medium may be regarded as a computer memory which a computer terminal 123 or laptop 112 is certain to include. Or, one of ordinary skill in the art is certain to conclude that a computer terminal 123 or laptop 112 includes a computer readable medium in order to carry out the functions of such a computing device.

As for the presence server 303, the presence server interfaces with the shared resource 204 which provides storage for the presence information (see last 3 lines of page 9 of the specification). The presence server 303 also may be a computer readable medium because it also has a memory. Among the various operations performed in claims 38 and 39, each of these operations is performed with reference to the computer readable mediums provided by the presence server and/or the user. Therefore, the specification provides support for a computer readable medium, and claims 38 and 39 are in compliance with §112, first paragraph. Applicants submit that rendering the subject matter recited in claims 38 and 39 as failing to comply with §112, first paragraph, is clearly erroneous.

Clear Error 4: Combination Fails to Disclose or Suggest the maintaining steps and the sending of the notification as recited in independent claim 1 and similarly recited in independent claims 11, 17, 18, and 34-41.

Claims 1-6, 11-23, 25-29 and 34-41 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bobde (U.S. Patent Publication No. 2003/0217142) in view of Holt (U.S. Patent Publication No. 2008/0244026). Applicants respectfully submit that this rejection contains clear error. The combination of Bobde, and Holt fails to disclose or suggest all the limitations of any of independent claims 1, 11, 17, 18, and 34-41 and related dependent claims.

For instance, a combination of Bobde and Holt fails to disclose or suggest “maintaining, in a first network element...registration information from a plurality of users...maintaining, in a second network element...information associated with said plurality of users, said second network element information comprising a record of registration information that is separate from the registration maintained in the first network element, wherein the second network element is separate from the first network element...and...said information associated with said at least one user comprising registration status information of a network device operated by said user”, as recited, in part, in independent claim 1 and similarly in independent claims 11, 17, 18 and 34-41.

Instead, Bobde discloses a system for detecting and communicating the presence of one or more computing devices. Bobde also discusses a method and system for aggregating presence information generated by multiple devices associated with a single user. Bobde describes a single server acting as a presence agent and a registration agent. Bobde also discloses a single server 102 acting as both a presence agent and a registration agent. Referring to FIG. 3 of Bobde, the server 102 includes a registration program 154 and a presence agent 152 as part of the server 102. In other words, Bobde describes a single network element (i.e., server 102) upon which a first presence application can be run and a second registration agent can also be run. Both agents have access to the same information source of the server 102.

Consequently, Bobde does not disclose two separate network elements (e.g., a first network element and a second network element, or, a presence server and a registrar server) as in the present independent claims. Bobde also does not teach or suggest two “separate” pieces of registration information as in the present independent claims. Instead, Bobde illustrates a single registration application “R” used by the entire server 102. Although, in Bobde, the presence agent 152 is illustrated as being in direct communication with the registration application 154, whatever registration information is used by the presence agent 152 or any other part of the server 102, that information is certainly only stored in the registration application 154. In other words, there is no second “separate” registration information provided anywhere.

In addition to the above-noted deficiencies of Bobde, the type of system illustrated in Bobde is similar to the type of system that is disclosed in the specification as being prior art (see FIG. 2 of the present application). Referring to FIG. 2, the single network entity 206 includes a registrar 203 and a presence server 205 in the same network element. FIG. 3 of the present application illustrates two separate network entities 301 and 303, which include the registrar 302 and the presence server 304. The independent claims clearly recite that there are two separate network entities similar to FIG. 3. Bobde does not disclose two separate network entities that both keep records of registration related information. In addition to the above-noted deficiencies of Bobde, Holt further fails to cure those deficiencies.

Furthermore, contrary to the contentions made in the Office Action, Holt does not cure the deficiencies of Bobde. Therefore, a combination of both references, would fail to teach or suggest all the claimed recitations. For instance, Holt discloses a system for providing presence and availability status information from a first user to a second user. The system includes a presence availability server for storing presence and availability status information. The presence availability server detects a change in presence status and/or availability of the first user, and informs a notification server of the change in status of the first user. In turn, the notification server sends the status change information of the first user to the second user.

The Office Action alleged that Holt discloses sending a subscribe message for an event from the second network element to the first network element (see paragraphs [0019] and [0025] of Holt). Referring to FIG. 1 in Holt, it appears that the Office Action has relied on the signaling from the presence availability server (i.e., second network element) to notification server (i.e., first network element) as allegedly disclosing the features recited in claim 1. According to Holt, the presence availability server sends a change in the presence status of a user to a notification server. Contrary to the example disclosed in Holt, in the present patent application, registrar server (i.e., first network element) maintains the registration information of the user and the presence server (i.e., second network element). In addition, the presence server subscribes to the registrar server to obtain changes in presence and registration status of the user. The registrar server (i.e., first network element) would then notify presence server (i.e., second network element) of any changes in the presence status of the user.

Claim 1 of the present application recites “sending a subscribe message for an event from the second network element to the first network element, wherein the event is a change in the registration information of at least one of the plurality of users...receiving at the first network element a register message from at least one user, said message changing the registration information of said at least one user...sending a notification from the first network element to the second network element in response to the register message.” In the present application, the registrar server maintains the user registration information and the presence server subscribes to the registrar server for the changes in presence status of the user. In addition, the registrar server sends a notification to the presence server when changes occur.

In Holt, there is no registrar server as described in the present patent application. Holt discloses that a presence availability server that detects a change in status of a user and then sends a notification to a notification server so that the notification server can inform a different user. Holt discloses that a presence availability server is configured to detect a change in presence or availability status of the user (see Abstract of Holt). The change is detected without a registrar server contacting the presence server. Holt does not disclose any type of separate registrar server. The presence notification server in Holt provides its own determination scheme to obtain status information.

Therefore, Bobde and Holt, individually or combined, do not disclose or suggest the maintaining steps and the sending of the notification as recited in independent claim 1 and similarly recited in independent claims 11, 17, 18, and 34-41. This failure constitutes clear error, which requires withdrawal of the rejection of claims 1-7, 11-30 and 34-41.

Clear Error 5: Combination Fails to Disclose or Suggest: sending, by a third entity, a subscribe message to the second entity for information associated with said at least one user.

Claims 8, 9, 31 and 32 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bobde in view of Holt and further in view of “IMPS – Instant Messaging and Presence using SIP” of Donovan (“Donovan”). Applicants respectfully submit that this rejection contains clear errors.

Claims 8, 9, 31 and 32 depend respectively from, and further limit, claims 1 and 18. At least some of the deficiencies of Bobde and Holt with respect to claims 1 and 18 are discussed above. Donovan does not remedy the above-discussed deficiencies of Bobde and Holt, and, thus, the combination of Bobde, Holt, and Donovan fails to disclose or suggest all of the elements of any of the presently pending claims.

Donovan generally relates to Instant Messaging and Presence using SIP (IMPS), and was not cited with regard to the above-discussed features with respect to which the combination of Bobde and Holt is deficient. Donovan fails to remedy the above-identified deficiencies of Bobde and Holt because Donovan also fails to disclose “sending a subscribe message for an event from the second network element to the first network element, wherein the event is a change in the registration information of at least one of the plurality of users...receiving at the first network element a register message from at least one user, said message changing the registration information of said at least one user...sending a notification from the first network element to the second network element in response to the register message”, as recited in claim 1 and similarly in independent claims 11, 17, 18 and 34-41. Accordingly, it is respectfully submitted that the combination of Bobde, Holt and Donovan fails to disclose or suggest all of the elements of claims 8-9 and 31-32. This failure constitutes clear error, which requires withdrawal of this rejection.

Clear Error 6: Combination Fails to Disclose or Suggest: the sending of the subscribe message comprising sending a session initiation protocol SUBSCRIBE message, and the sending the notification comprises sending a session initiation protocol NOTIFY message.

Claims 7, 10, 24, 30, and 33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bobde in view of Holt and Donovan and further in view of U.S. Publication No. 2002/0131395 to Wang ("Wang"). Applicants respectfully submit that this rejection contains clear errors.

Claims 7, 10, 24, 30, and 33 depend respectively from, and further limit, claims 1, 17, and 18. At least some of the deficiencies of Bobde, Holt, and Donovan with respect to claims 1, 17, and 18 are discussed above. Donovan does not remedy the above-discussed deficiencies of Bobde, Holt, and Donovan, and, thus, the combination of Bobde, Holt, Donovan, and Wang fails to disclose or suggest all of the elements of any of the presently pending claims.

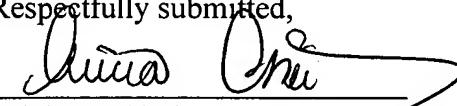
Wang generally describes a session initiation protocol (SIP) user agent in a serving GPRS support node (SGSN). Wang describes that a SIP application service can be connected to an SGSN by a SIP user agent. Wang discusses, in FIG. 12 for example, that a mobile station can register itself to a first presence server (216), which, in turn, forwards any changes in registration to the home presence server (1206). The two presence servers, however, are operated in such a way that the presence server that is visited only passes information directly to the home presence server that then fields any request from a watching agent.

However, Wang fails to disclose sending a subscribed message for an event from the home presence server to the visited server wherein the event is a change in the registration information. The communications disclosed in paragraph [0080] of Wang include a users A and B communicating back and forth, and a presence server 126 belonging to user A's home network. In operation, user B subscribes to user A's presence status by contacting user A's home presence server. There is no indication of any registration information being stored at two separate network elements.

Similar to the deficiencies in Bobde, Holt, and Donovan, Wang also fails to disclose the maintaining steps and the sending of the notification as recited in independent claim 1 and similarly recited in independent claims 17 and 18. Accordingly, a combination of Bobde, Holt, Donovan, and Wang would fail to teach or suggest all the claimed features of independent claims 1, 17, and 18 and, therefore, related dependent claims 7, 10, 24, 30, and 33. This gap in the teachings of the references, constitutes clear error in the rejection, which requires withdrawal of this rejection.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,


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Enclosures: Petition for Extension of Time ; PTO/SB/33 Form ; Notice of Appeal

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